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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,654	07/20/2001	Rodger Burrows	02154.001	2617

7590 05/24/2005

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/910,654

Applicant(s)

BURROWS, RODGER

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Request to Reopen Prosecution and Response to the January 25, 2005 Board of Patent Appeals and Interferences (BPAI) Decision filed on March 28, 2005 under 37 CFR 41.50(b)(1) has been considered but is ineffective to overcome the ARC references. The currently pending claims considered below are Claims 1-15, 17, and 18.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARC references submitted by the Applicant.

Claims 1-15, 17, and 18: The BPAI Decision presented the following rejection of these claims as being obvious over the ARC references:

"We reject Claims 1-15, 17, and 18 under 35 U.S.C. 103(a) as being unpatentable over the prior art submitted by the appellant which has collectively been labeled ARC. We incorporate the finding made by the examiner in rejecting these claims under 35 U.S.C. 102(f) except for the finding that ARC discloses the electronic

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storage of coupon data. Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the examiner, we agree with the examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that coupon data should be stored in optical form. At the time this application was filed, it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multimedia network transmission. Thus, although ARC in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction of the image."

The Examiner adds that as cited by the Applicant in the Response in Exhibits 1 and 2 (the 2000 IAH and 2005 IAH references) "ARC stated...all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses 'write-once, read only' technology which will prevent overwriting...However, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable. (emphasis in the original)". This passage teaches one of ordinary skill in the art (i.e. artisan) that the supporting documents (including the agent coupon) could be stored on microfiche, microfilm, non-magnetic optical medium, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media, but that such storage would not be acceptable to the ARC, except for the first three. This clearly discloses that alternate means for storing the supporting documents were not only known at the time, but also considered by the ARC. Whether or not the ARC would accept storage of

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the agent coupon data on a certain type of storage media does not remove the teaching of such by the above passage. The rules and regulations are subject to change by the ARC at any time. The requirement to store an agent coupon may be eliminated altogether in the future, additional forms may be added to the required storage list, or a new type of storage medium may be developed and accepted by the ARC in the future. However, none of these possibilities would remove the obviousness of storing the agent coupon data (or any other documents or forms) on the various types of storage mediums available at the time.

### ***Response to Arguments***

4. Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive.

a. The Applicant argues "that ARC only disclosed the storage of an optical image of the agent coupon and not electronic storage of agent coupon data" (pages 2-5). The Examiner notes that in the passages from the 2000 IAH and 2005 IAH references cited by the Applicant in the Response, the ARC discloses that the agent may "maintain the required documents on microfiche/film or **on an optical storage medium**"..."which will prevent overwriting" (emphasis added). This citation does not state that an optical image of the agent coupon is being stored, only that the required documents (which would include the agent coupon) may be stored on an optical storage medium that cannot be overwritten. Such optical storage media known at the time were CDs, DVDs, WORM disks, etc. Many of these devices would have met the write-once,

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read only criteria of the ARC. For example, the *Microsoft Computer Dictionary, Third Edition*, printed in 1997, defines "compact disc" as "An optical storage medium for digital data" and when defining "compact disc – erasable" states "Contemporary CDs are 'write once, read many', in that the information originally written cannot be changed, but can only be appended to." (page 104). Thus, as the rejection in the BPAI Decision concludes, it would have been obvious to an artisan at that time to store the agent coupon and the other supporting documents as digital data on an optical storage medium such as a CD.

b. The Applicant's argument that the invention achieved the same goal as the ARC but not by using the same method disclosed or suggested by the ARC (pages 5-6) is not persuasive. As discussed above, the ARC discloses various types of storage medium upon which the supporting documents could be stored, but placed a caveat on what criteria had to be met by the storage medium before it would be accepted to the ARC, namely that the storage medium could not be overwritten. The Examiner notes that in Claim 3 the Applicant is claiming that the storage medium used in the invention is a hard drive, one of the storage mediums explicitly mentioned (suggested) by the ARC. Thus, the invention is achieving the same goal as the ARC and using a method at least suggested by the ARC.

c. The Applicant argument that the Board's reference do not teach the applicant's invention (pages 7-8) is not persuasive and has been addressed in the responses above.

d. The Applicant's argument that the Board has not made a showing of a prima facie case of obviousness (pages 8-13) is not persuasive and has also been addressed in the responses above.

e. The Applicant's argument that the ARC disclosures teach away from the Applicant's claimed invention (pages 14-15) are not persuasive. As discussed above, the passages cited by the Applicant explicitly teach various types of storage mediums upon which the data could be stored, but then select the ones which the ARC finds acceptable (e.g. ones that cannot be overwritten). A reference which teaches a plurality of alternatives does not teach away from a disclosed alternative by selecting a different alternative as the preferred embodiment.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

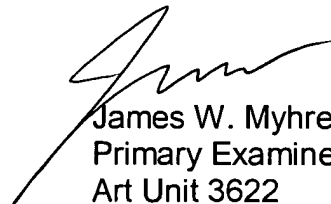
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.

  
JWM  
May 18, 2005

  
James W. Myhre  
Primary Examiner  
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